

PATENT  
Our Case No. D5216

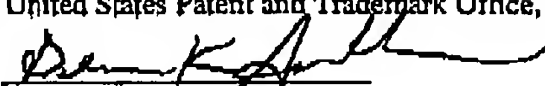
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Joseph R. Ward et al. ) Group Art Unit 1725  
Serial No.: 10/027,071 ) Examiner: Kevin P. Kerns  
Filed: December 20, 2001 )  
For: METHOD FOR MANUFACTURE OF )  
GREY CAST IRON FOR CRANKCASES )  
AND CYLINDER HEADS )

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)872-9306, on March 2, 2005.

  
Dennis K. Sullivan  
Attorney for Applicant

Response To Notification of Non-Compliant Appeal Brief

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed February 10, 2005, Applicant traverses the finding that the Appeal Brief filed on December 22, 2005 is defective and requests withdrawal of the requirement to file a complete new brief.

The Notification states that the brief does not contain a statement of the status of all claims. The Examiner's attention is directed to page 2 of Appellant's Brief that contains such a Status of Claims statement at Section III of the Brief. In particular, Claims 1-5 and 9-17 are identified as "Claims rejected."

The Notification further states "the appeal brief is defective since claims 1-5 and 9-17 lack proper claim status identifiers." There is no requirement in the Rules of Practice to provide "claim status identifiers" in an Appeal Brief.

Rather, 37 CFR §41.37 Appeal Brief sets forth the requirements for the contents of the Appeal Brief. 37 CFR §41.37(c)(1)(iii) states "*Status of Claims*. A statement of the status of all

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of the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.”

“Claim status identifiers” are required only in the Revised Amendment Practice under 37 CFR §121; however, that rule does not pertain to the requirements for the contents of the Appeal Brief. Moreover, it is noted that the status identification examples quoted in 37 CFR §41.37 above are very different than the claim status identifiers mandated in the Revised Amendment Practice. For example, there is no “Rejected” claim status identifier in the Revised Amendment Practice.


Similarly, although the Appendix to Appellant’s Brief contains a copy of the claims involved in the appeal, there is no requirement in 37 CFR §41.37 that the claims have claim status identifiers. Indeed, MPEP §1206, relating to the former rule on Appeal Brief content, states that: “The copy of the claims required in the brief Appendix ... should be a clean copy and should not include any markings such as brackets or underlining.”

For the above reasons, Appellant submits that Appellant’s Brief filed December 22, 2005 in the above-identified application is not defective and is in compliance with 37 CFR 41.37. Accordingly, withdrawal of the requirement for a complete new brief is solicited.

Should the Examiner continue to hold that Appellant’s Brief is defective, the Examiner is invited to call Appellant’s attorney at the number below to discuss this holding. Additionally, a citation to a specific rule requiring “claim status identifiers” in an Appeal Brief would be appreciated.

Warrenville, IL 60555  
Date: March 2, 2005  
Telephone: (630) 753-2311

Respectfully submitted,

  
Dennis Kelly Sullivan  
Attorney for Appellant  
Registration No. 26,510